

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Anja KLEIN ET AL.

Serial No. 09/530,386

Group Art Unit: 2684

Confirmation No. 7374

Filed: April 27, 2000

Examiner: Nguyen, Tu X

For: METHOD, MOBILE STATION AND BASE STATION FOR CONNECTION SETUP IN A
RADIO COMMUNICATION SYSTEM

REPLY BRIEF UNDER 37 C.F.R §§ 41.41

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Entry of this Reply Brief is respectfully requested. This Reply Brief is submitted in response to the Examiner's Answer, mailed October 20, 2006.

I. STATUS OF CLAIMS

Claims 18-21 and 24-35 are pending in this application at the filing of this Reply Brief. Claims 18-21 and 24-35 have at least been twice rejected. Claims 18, 33, 34, and 35 are independent claims, and claims 19-21 and 24-32, are dependent claims.

II. GROUNDS OF REJECTION

1. Claims 18-20, 24-29, and 31-35 stand rejected under 35 USC 103 as being obvious over Jolma et al., U.S. Patent 5,806,003, in view of Gardner et al., U.S. Patent No. 5,729,557, and Hayashi et al., U.S. Patent No. 6,069,884, and Oberholtzer et al., U.S. Patent No. 5,465, 399.

2. Claim 21 stands rejected under 35 USC 103 as being obvious over Jolma et al., Gardner et al., Hayashi et al., and Oberholtzer et al., in view of Gilhousen et al., U.S. Patent No. 5,485,486.

3. Claim 30 stands rejected under 35 USC 103 as being obvious over Jolma et al., Gardner et al., Hayashi et al., and Oberholtzer et al., in view of Bender et al., U.S. Patent No. 6,366,779.

III. ARGUMENT

Briefly, it is noted that the Examiner's Answer has not addressed any remarks or comments presented in the Appeal Brief filed August 7, 2006, and only references the previous Appeal Brief of July 30, 2004, and the Request for Reinstatement and Supplemental Appeal Brief of February 22, 2005. The Appeal Brief filed August 7, 2006, was filed in response to the Notice of Non-Compliant Appeal Brief mailed July 5, 2006. Further, it is noted that though portions of the original Appeal Brief of July 30, 2004, and the Appeal Brief filed August 7, 2006, are similar, they are not identical.

Accordingly, with this in mind, the relevance of the Examiner's remarks in the outstanding Reply Brief should be more clear, as it was initially unclear why the Examiner was responding to remarks in the 2004 Appeal Brief and the 2005 Supplemental Appeal Brief when applicants had recently filed the August 7, 2006 Appeal Brief, apparently necessitating the submission of the October 20, 2006 Examiner's Answer.

Regardless, in response to applicants multiple remarks, the Examiner has set forth only three particular disagreements.

First, beginning on page 8 of the Examiner's Answer, though the point being made in the Examiner's comments is unclear, the Examiner is apparently rebutting applicants contentions that it would not have been obvious to look to Hayashi et al., U.S. Patent No. 6,069,884, to add a feature from Hayashi et al. to Jolma et al., U.S. Patent No. 5,806,003.

Specifically, on page 8, beginning in paragraph 3, in the Appeal Brief of July 30, 2004 (with similar discussions in the current Appeal Brief of August 7, 2006, at least being represented on pages 10-11), applicants pointed out what feature the Examiner indicated was missing from Jolma et al., and proceeded to point out why such an addition to Jolma et al. from Hayashi et al. would not have been obvious.

In presenting their arguments, applicants pointed out the use of multiple antennas in Hayashi et al., as merely one example of the differences between Hayashi et al. and Jolma et al. and CDMA and GSM architectures.

In the Examiner's Answer, the Examiner would appear to argue that the rejection is not based on the use of three antenna in Jolma et al., but the incorporation from Hayashi et al. of a use of multiple codes to separate information connections between base stations and the mobile stations, which Examiner thereafter summarily argues would have been obvious even though "Jolma and Hayashi et al. are using different signal structure but would be obviously combinable

for the systems that are both providing connections between the base station and mobile terminals."

Here, applicants have recognized the Examiner's position and the proposed modification of Jolma et al., but have attempted to point out the multiple differences in both data/signal structure and signaling environment between the systems of Jolma et al. and Hayashi et al., with the above reference to the multiple antenna of Hayashi et al. being merely one of these examples.

Further, as pointed out the Appeal Brief of August 7, 2006, a multitude of other rejection rationale are similarly structured as the above proposed modification of Jolma et al. to include a feature from Hayashi et al., i.e., that regardless of differences between references, the rejections are based on an argument such a combination would have been possible since both are in a similar field of communicating between a mobile unit and a base station.

However, if such an obvious to try or "obviously combinable" conclusion was valid just because references dealt with communicating between a mobile unit and a base station, then it would have been obvious to add the same feature to each and every reference in the entire field. Which cannot be considered a valid statement. The implementation of a feature in Hayashi et al. is for a particular purpose and advantage in the environment of Hayashi et al. Just because Jolma et al. also communicates with a base station does not mean that each and every feature of Hayashi et al. would have been obvious to modify into Jolma et al. There must be at least something that links the desire/need/benefit between this feature in Hayashi et al. and Jolma et al.

In the Examiner's Answer, the second response to applicants' remarks is presented in the first paragraph on page 9, where the Examiner rebuts applicants' argument that there is not evidence of support that Jolma et al. would need or desire the additional feature from Oberholtzer et al., U.S. Patent No. 5,465,399. This response is apparently in response to applicants' Appeal Brief of July 30, 2004, on pages 10-11, and similarly set forth in the August 7, 2006, Appeal Brief at least on page 15-16.

Here, in the Examiner's Answer, and similar to previous Office Action, the Examiner has pointed to portions of the relied upon reference to cite benefits of some feature in that reference and in the environment of that reference without any connection with Jolma et al. The Examiner has argued that regardless of the needs or desires of Jolma et al., it would have been obvious to modify Jolma et al.

However, applicants particularly pointed out that Jolma et al. already addressed the problem discussed in Oberholtzer et al., and solved the problem in a preferred manner, differently from that disclosed by Oberholtzer et al. Jolma et al. does not need or desire the feature the Examiner is attempting to modify into Jolma et al.

It should be noted that, similar to the above discussion regarding the adding of a feature to Hayashi et al. to Jolma et al., the Examiner has attacked applicants' arguments by picking a paragraph from a whole discussion attempting to explain why the purported missing feature would not have been obvious to modify into Jolma et al. Applicants here argued both that there is no evidenced need or desire for the addition of the claimed feature into Jolma et al. and that Jolma et al. "already includes a mechanism to ensure the reception of the mobile station...", but the Examiner has chosen to pick apart the argument and focus on each alone, i.e., when explaining why a feature would not have been obvious for inclusion into Jolma et al. because Jolma et al. already includes a feature that accomplishes this goal, the Examiner rebuts the argument by saying that he is not arguing that it would have been obvious to modify Jolma et al. in that manner, or regarding that feature.

This picking and choosing of arguments and discussions is similarly set forth in the outstanding rejection where the Examiner determines which features are missing and then finds a number of references with the missing features, then concludes that since they are in the same field (communicating between a mobile station and a base station) then the addition/modification would have been obvious.

Rather, applicants have attempted to clearly explain why each feature would either not be modified into Jolma et al. or how Jolma et al. would not need or desire the same.

Lastly, the Examiner's Answer further cites applicants Supplemental Appeal Brief of February 22, 2005, rebutting applicants' comments that the Examiner has failed to properly address the claimed pilot signal, beginning at the bottom of page 9.

Though not clear, the Examiner's Answer appears to argue that a signal within Jolma et al. could be a pilot signal, since Hayashi et al. implements a pilot signal for discerning the power of the base station. Similar to above, the Examiner's argument is based on the conclusion that it would have been obvious to try or that such a signal "could" be used in Jolma et al. It is respectfully submitted that this is not a proper prima facie obviousness argument.

As pointed out by applicants, the power determination systems between Jolma et al. and Hayashi et al. are substantially different, such that there is no need for the such a use of the

referenced pilot signal by Jolma et al. since Jolma et al. does not have to sample the power level before communicating and that it wants to make sure that its signal is received. Thus, regardless of a proposition that Jolma et al. could be modified, there is no reason for the same.

In summary, the outstanding rejections of both the independent claims and the dependent claims are based on a disregard of the underlying system of Jolma et al. This is briefly evidenced in the fact that Jolma et al. fails to disclose a majority of the claimed features from the independent claims, and that each modification of Jolma et al. requires further incorporation of the newly modified features to lend support for the addition of the newly missing feature, i.e., in some manner, the disclosures of Hayashi et al. and Oberholtzer et al. must be bodily incorporated into Jolma et al. before there is any reason for modifying the modified reference to add in features from the other Oberholtzer et al. or Hayashi et al. In the end, there is still no primary support for adding any of the referenced features to Jolma et al., other than the Examiner's un-evidenced conclusion that the same could be "combinable" into/with Jolma et al.

Further, though applicants have presented technical reasons and discussions lending away from the proposed obviousness conclusion, the Examiner has merely discounted the same.

IV. Conclusion

In view of the law and facts stated herein, the Appellant respectfully submits that the Examiner has failed set forth a prima facie obviousness case against the pending claims.

For all the foregoing reasons, the Appellant respectfully submits that the cited prior art does not teach or suggest the presently claimed invention. The claims are patentable over the prior art of record and the Examiner's findings of unpatentability regarding claims 18-21 and 24-35 should be reversed and the patentability over the presently cited references be affirmed.

The Commissioner is hereby authorized to charge any additional fees required in connection with the filing of this Reply Brief to our Deposit Account No. 19-3935.

Respectfully submitted,

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